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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,035	06/06/2001	Gerard Jaeger	Q64439	7609

7590

08/27/2003

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EXAMINER

OLSEN, KAJ K

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/874,035

Applicant(s)

JAEGER, GERARD

Examiner

Kaj Olsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claim 1, it is unclear what the metes and bounds of the term “small dimensions” would be. What would one possessing ordinary skill in the art reasonably construe as being a small dimension?
4. In claim 1, it is unclear how to interpret the limitation “intended to be coated with a specific reagent”. Is the specific reagent part of the claimed invention? Apparatus claims should be constructed only with clear and explicit recitation of structure that is meant to comprise the invention.
5. In claim 1, the term “measuring window” lacks antecedent basis. Earlier applicant only referred to first and second windows.
6. In claims 1 and 2, the term “the direction of the tongue” is confusing. Applicant hasn’t specified any sense of direction for the tongue making unclear what direction the applicant is referring to.
7. In claim 4, it is entirely unclear how to interpret the limitation calling for a “coffee bean configuration”. What would one possessing ordinary skill in the art reasonably construe as being a coffee bean configuration? Although it appears the applicant is referring to the shape shown for elements 9a and 9b from figure 2, it is entirely unclear whether a similar shape (e.g. two semicircles) could be construed to as being a coffee bean configuration or not. Clarification is requested.

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8. In claim 5, there is no antecedent basis for "the electrons".

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saurer et al (USP 5,395,504).

11. With respect to claims 1 and 2 as best understood, Saurer discloses an electrochemical sensor comprising a tongue having a plastic substrate 1 supporting at least two current conducting strips (16, 17) separated by the substrate (fig. 1-3). Said strips are covered by a plastic covering film 29 (col. 5, lines 42-49) into which are cut openings for the connection to electrical components 32 as well as first and second windows (35, 36) for the reference and working electrodes (fig. 1-3 and col. 5, lines 50-68). With respect to the measuring window possessing an oblong contour, the ordinary and customary meaning of the term "oblong" is "deviating from a square, circular, or spherical form by elongation in one dimension" (see attached definition from the Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition). By this definition, the semicircles (35,36) of Saurer are oblong because a semicircle clearly deviates from a circular structure and is elongated in one dimension (i.e. it is twice as long in one dimension as in the other) that is pointing in the direction of the tongue. Furthermore, Saurer sets forth in its disclosure that the windows shown may have "any suitable shape" including

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elliptical (col. 5, lines 56-60). An elliptical structure can also be construed as having oblong contours.

12. With respect to claim 3, the windows are symmetrical about the narrow insulating strip separating the conductive strips (see fig. 1 and 4).

13. With respect to claim 4 as best understood, the shapes of the windows shown in fig. 1 and 4 would appear to read on the claim terminology "coffee bean configuration" assuming a coffee bean configuration is any structure that is vaguely semicircular (compare 36 and 38 of fig. 1 of Saurer with fig. 2 of the instant invention). However, even if the applicant claim terminology doesn't read on the shape shown by Saurer, Saurer admitted that any suitable shape could be used for the window geometries (col. 5, lines 56-60). It would have been obvious to one of ordinary skill in the art at the time the invention was being made to utilize a shape that reads on the term "coffee bean configuration" because such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

14. With respect to claim 5, see col. 5, lines 64-68.

15. With respect to claim 7, and the depositing of a specific reactant via pipette, the determination of patentability for the claim is based on the product itself. Because the product of the claim is identical to the invention of Saurer the process from which it was made is the same as or obvious over the process utilized by Saurer (see *In re Thorpe*, 777 F.2d 695, 698).

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***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saurer in view of Graetzel et al (USP 5,378,628).

18. The references set forth all the limitations of the claims, but did not explicitly recite the use of the set forth mediators. Graetzel discloses some of the claimed mediators (see table I) and further discloses that these mediators have a number of advantages over conventional mediators in the art including good electrochemical potential, solubility and stability (col. 2, lines 49-54). It would have been obvious to one of ordinary skill in the art at the time the invention was being made to utilize the teaching of Graetzel for the sensor of Sauer in order to provide good electrochemical performance and good shelf life for the sensor.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frenkel and Desarzens also disclose the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (703) 305-0506. The examiner can normally be reached on Monday through Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322.

When filing a fax in Group 1700, please indicate in the header "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of this application. This will expedite processing of your papers. The fax number for regular communications is (703) 305-3599 and the fax number for after-final communications is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Kaj K. Olsen', with a stylized flourish extending to the right.

Kaj K. Olsen  
Patent Examiner  
AU 1753  
August 22, 2003